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RESPONSE AFTER FINAL REJECTION
EXPEDITED PROCEDURE
EXAMINING GROUP 1619

PATENT
Attorney Docket No. 5725.0470-01

#12
3-27-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Jean-Michel STURLA et al.	)	
	)	
Application No.: 09/385,412	)	Group Art Unit: 1619
	)	
Filed: August 30, 1999	)	Examiner: R. BAWA
	)	
For: AEROSOL DEVICE CONTAINING A POLYCONDENSATE COMPRISING AT LEAST ONE POLYURETHANE AND/OR POLYUREA UNIT	)	

Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Sir:

In response to the Final Office Action dated January 9, 2001, Applicants respectfully request that the rejections set forth in the Office Action be reconsidered and withdrawn in view of the following remarks and those of the Request for Reconsideration filed October 18, 2000. Currently, claim 1 is pending in this application.

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I. *Personal Interview*

Initially, Applicants would like to thank the Examiner for the courtesies extended to their representatives, Thomas Irving and Matthew Latimer, at the personal interview at the U.S. PTO

on February 13, 2001. Applicants believe that the following remarks will clarify their position with respect to the outstanding rejections.

II. *Rejections Under 35 U.S.C. § 102(b)*

The Examiner maintains the rejections of claim 1 under 35 U.S.C. § 102(b) as anticipated by Thomaides *et al.* (U.S. Patent No. 5,626,840) or WO 94/3510. Office Action at paragraph 2. Applicants respectfully traverse these rejections and submit that the Examiner has failed to set forth a *prima facie* case of anticipation of claim 1. In maintaining the rejections, the Examiner makes two assertions and draws a final legal conclusion based on these assertions. Each assertion, as well as the legal conclusion, is discussed in detail below.

The first assertion made by the Examiner is that present claim 1 is directed to an aerosol composition contained in an aerosol device, and that aerosol devices for delivering compositions are well known in the art. Applicants respectfully disagree and submit that, whether or not aerosol devices are well known in the art, present claim 1 is directed to an aerosol device, not a composition *per se*. Thus, in order to anticipate present claim 1, the cited references must disclose, among other things, an aerosol device.

The second assertion made by the Examiner is that each and every element of claim 1 is either identically disclosed by the cited art or inherent in the disclosure. Applicants respectfully traverse this assertion, and request that the Examiner specifically identify the passages in Thomaides *et al.* or WO 94/03510 that disclose each and every claim limitation of claim 1. For example, Applicants request that the Examiner identify the passages of either of the cited references that disclose a composition comprising 1) at least one polycondensate comprising at

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least one sequence chosen from polyurethanes and polyureas, wherein the polycondensate is formed by an arrangement of blocks obtained from at least one compound which contains at least two active hydrogen atoms per molecule, at least one diol containing at least one functional group chosen from acid radicals and salts thereof, and at least one isocyanate chosen from di- and polyisocyanates; and 2) an organic solvent, wherein the weight ratio of the propellant to the organic solvent is greater than or equal to 1.5:1. Applicants also request that the Examiner identify the passages of each of the cited references that disclose an aerosol device that is suitable for giving an initial flow rate of aerosol composition of less than or equal to 0.75 gram per second. All of these elements are recited in present claim 1, and thus must be disclosed in the cited art for a rejection under 35 U.S.C. § 102 to be proper. As discussed in the Request for Reconsideration filed October 18, 2000, Applicants have not been able to identify passages in the cited references that disclose all of the elements of claim 1.

The Examiner has relied on the theory of inherency to support his rejection. Applicants respectfully submit that the Examiner's reliance on the theory of inherency is misplaced. Applicants submit that "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the present application, the Examiner has failed to satisfy this requirement because the information disclosed in the cited references, coupled with the general knowledge in the art, are insufficient to support a presumption of inherency. In particular, the Examiner has failed to provide a basis in fact and/or technical reasoning showing that all aerosol devices that are "well

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known in the art" would be capable of delivering the composition of present claim 1 at "an initial flow rate of aerosol composition of less than or equal to 0.75 grams per second", as recited in present claim 1. Furthermore, and equally importantly, the Examiner has failed to provide a basis in fact and/or technical reasoning showing that the compositions of the cited references can be delivered by an aerosol device at "an initial flow rate of aerosol composition of less than or equal to 0.75 grams per second", as recited in present claim 1.

If the cited references disclose containers or devices that might, but do not necessarily, deliver a composition satisfying the requirements of claim 1 at an initial flow rate of aerosol composition of less than or equal to 0.75 grams per second, then the Examiner cannot rely on the theory of inherency to reject the present claim. Likewise, if the cited references disclose compositions that might be, but are not necessarily, capable of being delivered at an initial flow rate of aerosol composition of less than or equal to 0.75 grams per second, then the Examiner cannot rely on the theory of inherency to reject the present claim. Neither the first Office Action nor the Final Office Action provides any support for the contention that either cited reference discloses an aerosol device that necessarily would deliver the composition recited in present claim 1 at the recited initial flow rate and a composition that would necessarily be delivered at the recited initial flow rate. Applicants have reviewed the cited references, and have not identified any passages that provide such an inherent disclosure.

Finally, the Examiner draws the legal conclusion that "the subject matter defined by claim 1 would have been obvious within the meaning of 35 U.S.C. § 102." Applicants respectfully submit that 35 U.S.C. § 102 does not pertain to obviousness. Section 102 of Title 35 of the

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United States Code relates to anticipation of a claim (*i.e.*, to prior art disclosures of each and every element of a claim).

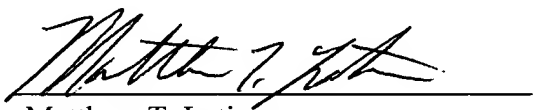
III. *Conclusion*

Applicants respectfully submit that the presently claimed invention is patentable over the cited art for at least the reason given above and in the previous response. Applicants respectfully request that the Examiner reconsider its rejections under 35 U.S.C. § 102 in view of his legal conclusion that present claim 1 is obvious (not anticipated). Applicants further respectfully request that the Examiner reconsider the rejections under 35 U.S.C. § 102, under the theory of inherency, in view of the apparent lack of sufficient disclosure in the cited references.

If the Examiner believes anything further is necessary in order to place this application in even better condition for allowance, Applicants' undersigned representative may be contacted at the telephone number or e-mail address listed below so that the necessary information or material can be provided. Please grant any extensions of time required to enter this Request for Reconsideration and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

By: 

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Date: March 21, 2001

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